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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,063	01/17/2001	Tony Yaksh	1133.029US1	7717

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

ROY, BAISAKHI

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,063

Applicant(s)

YAKSH ET AL.

Examiner

Baisakhi Roy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/17/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. The disclosure is objected to because of the following informalities: "oscillator" has been spelled incorrectly as "occilator".

Appropriate correction is required.

Claim Objections

3. Claims 1, 11, and 12 are objected to because of the following informalities:

"oscillator" has been spelled incorrectly as "occilator" in claims 1, 11, and 12

Appropriate correction is required.

Double Patenting

4. Applicant is advised that should claim 11 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halek et al. (4007420) in view of Farmer et al. (5458142) and further in view of Sakano (4968975).

Regarding claims 1, 11, and 12, Halek et al. discloses an apparatus and method for measuring the spatial displacement of an animal's paw injected with an irritant with said paw being in contact with a conductive surface, which serves as a detection assembly or device (abstract, col. 1 lines 5-10, col. 4 lines 8-59, col. 5 lines 35-42 59-68, col. 7 lines 1-5, and claim 1). Halek et al. does not disclose said apparatus to be consisting of a metal object attached to the animal's paw, which would be used to detect the spatial displacement of the animal's paw within the electromagnetic field. Farmer et al. discloses an apparatus and method for detecting the magnetic fields emanating from a metal object or sensor located adjacent to or in contact with a specific position on a living organism and connected to an amplifier, detection of the amplified signal, filtering

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and digitizing to detect an organism's response to a stimulation source such as irritants (abstract, col. 7 lines 9-12, col. 8 lines 60-67, col. 9 lines 1-21 lines 58-67, col. 10 lines 9-11 lines 26-29, and claims 1, 3, 6). It would have therefore been obvious to one of ordinary skill in the art to use the metal object based magnetic field detection teaching by Farmer et al. in the teaching by Halek et al. for the purpose of detecting the magnetic fields emanating from a metal object attached to an animal paw, which has been injected with an irritant. Halek et al. and Farmer et al. does not disclose said apparatus to be consisting of a cylindrical observation chamber housing the animal. In the same field of endeavor, Sakano discloses an apparatus and method consisting of a cylindrical observation chamber for detecting animal behavior such as reaction to external stimulation sources such as irritants (abstract, col. 1 lines 57-68, col. 2 lines 1-5, col. 2 line 5, col. 4 lines 50-54, claim 1). It would have therefore been obvious to one of ordinary skill in the art to use the cylindrical observation chamber teaching by Sakano in the teaching by Halek et al. and Farmer et al. for the purpose of housing an animal injected with the irritant and insuring that the animal will remain inside the boundaries of the electromagnetic field generated by the coil assembly.

Regarding claims 3-6, Halek et al. does not disclose said apparatus consisting of a metal object to be attached to the animal's paw, which would be used to detect the spatial displacement of the animal's paw within the electromagnetic field. Farmer et al. discloses an apparatus for detecting the magnetic fields emanating from a ferrous or non-ferrous metal object or sensor located adjacent to or in contact with a specific position on a living organism such as a paw in an annular or incomplete annular form

and connected to an amplifier, detection of amplified signal, filtering and digitizing to detect an organism's response to a stimulation source such as irritants (abstract, col. 7 lines 9-12, col. 8 lines 60-67, col. 9 lines 1-21 lines 58-67, col. 10 lines 9-16 lines 26-29, and claims 1, 3, 6). It would have therefore been obvious to one of ordinary skill in the art to use the metal object based magnetic field detection teaching by Farmer et al. in the teaching by Halek et al. for the purpose of detecting the magnetic fields emanating from a metal object attached to an animal's paw, which has been injected with an irritant.

Regarding claims 7-10, Halek et al. and Farmer et al. does not disclose said apparatus to be consisting of a cylindrical observation chamber housing the animal. Sakano discloses an apparatus consisting of a transparent plastic cylindrical observation chamber with individual compartments for testing a plurality of animals and multiple independent detection units for detecting animal behavior such as reaction to external stimulation sources (abstract, fig. 1, col. 1 lines 57-68, col. 2 lines 1-5, col. 2 lines 1-29 lines 37-51, col. 3 lines 32-49, col. 4 lines 50-54, claim 1). It would have therefore been obvious to one of ordinary skill in the art to use the cylindrical observation chamber teaching by Sakano in the teaching by Halek et al. and Farmer et al. for the purpose of housing an animal injected with an irritant and insuring that the animal will remain inside the boundaries of the electromagnetic field generated by the coil assembly.

7. Claims 1, 2, 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halek et al. in view of Ko et al. (4688580) and further in view of Sakano.

Regarding claims 1, 2, 11, and 12, Halek et al. discloses an apparatus and method for measuring the spatial displacement of an animal's paw injected with an irritant with said paw being in contact with a conductive surface, which serves as a detection assembly or device (abstract, col. 1 lines 5-10, col. 4 lines 8-59, col. 5 lines 35-42 59-68, col. 7 lines 1-5, and claim 1). Halek et al. does not disclose said apparatus to be consisting of a metal object attached to the animal's paw, which would be used to detect the spatial displacement of the animal's paw within the electromagnetic field. Ko et al. discloses an apparatus and method for detecting electromagnetic field to measure the spatial displacement along a bone structure with a field coil coupled to an oscillator for generating an electromagnetic field in the kilohertz range around the structure of interest with an amplitude detector (abstract, col. 2 lines 15-32 lines 49-54, col. 3 lines 35-55 lines 59-65, and claims 1). Ko et al. further discloses the creation of eddy currents perturbing the electromagnetic field and said perturbations are picked up, amplified, detected, and further amplified, filtered and digitized (col. 4 lines 30-44, claims 1, 2-13). It would have therefore been obvious to one of ordinary skill in the art to use the metal object based magnetic field detection teaching by Farmer et al. in the teaching by Halek et al. for the purpose of detecting the magnetic fields emanating from a metal object attached to an animal bone structure, which has been injected with an irritant. Halek et al. and Ko et al. does not disclose said apparatus to be consisting of a cylindrical observation chamber housing the animal. Sakano discloses an apparatus consisting of a cylindrical observation chamber for detecting animal behavior such as reaction to external stimulation sources such as

irritants (abstract, col. 1 lines 57-68, col. 2 lines 1-5, col. 2 line 5, col. 4 lines 50-54, claim 1). It would have therefore been obvious to one of ordinary skill in the art to use the cylindrical observation chamber teaching by Sakano in the teaching by Halek et al. and Ko et al. for the purpose of housing an animal injected with the irritant and insuring that the animal will remain inside the boundaries of the electromagnetic field generated by the coil assembly.

Regarding claims 7-10, Halek et al. and Ko et al. does not disclose said apparatus to be consisting of a cylindrical observation chamber housing the animal. Sakano discloses an apparatus consisting of a transparent plastic cylindrical observation chamber with individual compartments for testing a plurality of animals and multiple independent detection units for detecting animal behavior such as reaction to external stimulation sources (abstract, fig. 1, col. 1 lines 57-68, col. 2 lines 1-5, col. 2 lines 1-29 lines 37-51, col. 3 lines 32-49, col. 4 lines 50-54, claim 1). It would have therefore been obvious to one of ordinary skill in the art to use the cylindrical observation chamber teaching by Sakano in the teaching by Halek et al. and Farmer et al. for the purpose of housing an animal injected with an irritant and insuring that the animal will remain inside the boundaries of the electromagnetic field generated by the coil assembly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baisakhi Roy whose telephone number is 571-272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.R.
BR

Eleni Mantz Mercader
ELENI MANTZ MERCADER
PRIMARY EXAMINER
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